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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,856	08/02/2001	Gregory P. Fitzpatrick	BOC9-2000-0082(217)	7129

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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT PAPER NUMBER

2165

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,856

Applicant(s)

FITZPATRICK ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. The Request for Reconsideration filed on 4-January-2006 has been received and entered. Claims 1-17 are now pending.

Claim Objections

2. Claim 7 is objected to because of the following informalities:

Claim 7, line 4, recite "can be accessed" is indirect, suggest optionally, and passive which renders any recitation claimed after not be given patentable weight. It does not actually have to take place. Therefore giving little meaning to receiving an access request without actually performing it.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 4, 6, and 7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 4 and 6-7 are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application. The use of a computer has not been indicated.

These claims do not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim. Software or program can be stored on a medium and/or

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executed by a computer. In other words the software must be computer-readable. Furthermore, there is no hardware or storage tied to the claimed steps in order to realize their functionality.

Claim 1, for example; has no hardware tied to the claimed steps. There's no indication that "retrieving...comparing...identifying... and storing" is being done in a database or on a computer or anything other hardware.

Claim 4, for example; merely recite the step of "exchanging...comparing... and generating and storing" without indicating how these steps are performed. Is the computer or some other automated process? Or is the user manually performing them?

Moreover, claim 4 makes no indication of the actual "physical communication link" being a computerized communication link.

Similarly, claims 6-7 carry the same deficiency.

5. Claims 12, 15, and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 12, 15, and 17 are not limited to tangible embodiments. They recite the limitation "for causing the machine" in the preamble which in view of Applicant's disclosure, does not prohibit a computer from doing the recited acts. Such language does not cause any functionality to occur in the computer since they lack combination with hardware to realize the functionality. The steps of the claim do not ever have to actually take place. The language of "for causing" is intended use. Claims should be amended to recite "that" or "is" or "performing".

More so, in claims 15, and 17, preamble, the recitation of "for generating" is intended use and does not cause any functionality to occur in the computer since it lacks nexus with the body

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of the claim. The “generating a list of common contact” is never actually achieved in performing the bodily limitations.

6. Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 7 is not statutory because it merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application (see MPEP 2106 IV.B.2.(b)). The definitions given in the specification for a system is broad enough so as to not include a practical application within the technological arts, and no tangible result is produced in the claims. The claim should entail transformation of article or material to a different state or thing with final results achieved “useful, tangible, and concrete”. The claim should be amended so that some kind of output is required and/or so a tangible result is produced.

In claim 7, there is no indication of real world result/out put to the “a common contact list resulting...defining” steps appearing to take place. The actual accessing and displaying or presenting or showing the result is missing.

Allowable Subject Matter

7. Although no rejections in view of prior art are made, no claims in this application will be indicated as allowable until after a response to this action has been reviewed, as to the fact that certain changes may not produce allowable claims.

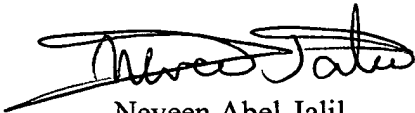
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Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Neveen Abel-Jalil
April 1, 2006